

REMARKS

Introduction

In accordance with the foregoing, no claims have been amended, cancelled or added. No new matter is being presented. Therefore, claims 2-6 remain pending in the application and reconsideration is respectfully requested.

Entry of Response

Since none of the claims are being amended and no new claims are being added, no new issues are raised by this response and further search and/or consideration of any new issues is unnecessary. Accordingly, entry of this response is respectfully requested.

Objections to the Drawings

The drawings were objected to. However, the applicant notes that the first and second chambers of the cylindrical tank (claim 2, line 2) correspond to reference numerals 1 and 4, respectively, in FIGS. 1 and 2 and are, therefore, shown in the drawings as required by 37 CFR 1.83(a). It is, therefore, believed that the objection has been properly addressed and, accordingly, it is requested that the objection be withdrawn.

Objections to the Specifications

The specification was objected to. According to the Examiner, it is not understandable how the cylinder 32 cylinder can pump the fluid in an open cylinder (5, FIG. 2) since the other cylinder appears to be stationery and the open cylinder is all that moves. Responsively, the applicant notes that, in FIG. 2, the cylinder 32 is stationery and the cylinder 5 moves while, in

FIG. 1, the cylinder 5 moves in connection with the stationery pneumatic cylinder 6. The cylinder 5 serves to occupy and un-occupy of space since the water flows through the level of the water level in tank 3 as water is raised from a first tank 1 to a level of pipe 28 by an electric motor 16 so that the water flows down the pipe to drive turbine 27. After the water leaves the turbine, it flows to a second tank, where it is allowed to flow back into the first tank, when the valve 10 is opened (after the tank is emptied). Given this explanation, it is believed that the specification is understandable on its face and, accordingly, it is requested that the objection be withdrawn.

Rejections under 35 U.S.C. § 101:

Claim 1 stands rejected under 35 U.S.C. §101 as the claimed invention allegedly lacks patentable utility. This rejection is traversed.

According to the Examiner, the amount of energy need to raise the water to the pipe is at least equal to the amount delivered to the turbine by the water flowing to the second tank and that all of the energy produced by the turbine is needed by the electric motor and that, therefore, “there is no production of energy.” The Examiner seems further troubled by the fact that friction in the system will add a further net energy loss. It would appear, therefore, that the Examiner’s conclusion is that the claimed invention is inoperative. Responsively, applicant notes his disagreement with the Examiner’s analysis and conclusion and submits that the claimed invention is clearly operative.

In MPEP 2107.01(II), it is stated that an invention is inoperative if it does not operate to produce the results claimed by the patent applicant. However, for this to be the case the claimed invention must also be totally incapable of achieving a useful result and that even a small degree of utility is sufficient. That is, the claimed invention must only be capable of performing some beneficial function and an invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely. A commercially successful product is not required, nor is it essential that the invention accomplish all its intended

functions or operate under all conditions. In short, according to the MPEP, the defense of non-utility cannot be sustained without proof of total incapacity.

In this case, claim 1 is directed to a hydraulic machine for generating electricity and recites features to that effect, which in practice have been seen to be 98% efficient. As such, the claims clearly meet the requirement of having at least some degree of utility regardless of any external suggestions made relating to the claimed invention's intended functions.

Moreover, the apparent fact that the Examiner questions whether the invention produces less energy than it receives is and should be beyond the scope of the Examiner's analysis under 35 USC § 101. This is especially true in light of the Examiner conflation of the *use and production of energy* versus the claimed *generation of electricity*, which are clearly not equivalent to one another and should not be regarded as such.

Thus, it is believed that claim 1 is directed to patentable subject matter and that, therefore, the rejection of claim is traversed.

Rejections under 35 U.S.C. § 112:

Claim 1 stands rejected under 35 U.S.C. §112, first paragraph as the claimed invention allegedly lacks patentable utility and claim 6 stands rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite due to its dependency upon claim 1. These rejections are traversed, however, in view of the remarks provided above and it is believed that the claims as presented are in condition for allowance.

Conclusion:

It is believed that the foregoing amendments and remarks place the application in condition for allowance and an early and favorable action to that effect is respectfully requested. The Examiner is invited to contact Applicants' attorney at the below listed phone number regarding this response or otherwise concerning the present application. Applicants hereby petition for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply. If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,
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